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EXAMINER	
SHAAWAT, MUSSA A	

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Please find below and/or attached an Office communication concerning this application or proceeding.

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AVNER SCHNEUR,
RINA ROTSHILD SCHNEUR,
GE LI, and
CHARLES H. ROSA

Appeal 2010-005652
Application 10/081,411
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Avner Schneur, et al. (Appellants) seek our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1-20. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE.[2]

THE INVENTION

The invention relates "to the production, design, and maintenance of business forms within a document management system." Specification 1:5-6.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A computer-implemented method for determining an optimal award schedule for satisfying a purchase requisition, the method comprising:
>
> receiving over a computer network, from each of a plurality of candidate suppliers, a corresponding plurality of bids;
>
> receiving, from a candidate supplier over said computer network, an explicit offer of a business-volume discount that is triggered when a purchase from the candidate supplier of at least one unit of a first qualifying item and at least one unit of a

[2] Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed Jul. 9, 2009) and Reply Brief ("Reply Br.," filed Dec. 15, 2009), and the Examiner's Answer ("Answer," mailed Oct. 15, 2009).

second qualifying item has an aggregated volume within a defined volume interval; and

determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Li US 2003/0004850 A1 Jan. 2, 2003

The following rejection is before us for review:

1. Claims 1-20 are rejected under 35 U.S.C. §102(e) as being anticipated by Li.

ISSUE

The issue is whether Li describes, expressly or inherently, a "determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount" (independent claims 1 and 8).

FINDINGS OF FACT

We rely on the Examiner's factual findings stated in the Examiner's Answer. Additional findings of fact may appear in the Analysis below.

ANALYSIS

All the claims call for the step of or instructions for "determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount" (claims 1 and 8, respectively). Accordingly, in order for Li to anticipate the claimed subject matter, Li must describe the step (claim 1) or instruction (claim 8), either expressly or inherently.

> A determination that a claim is anticipated under 35 U.S.C. § 102(b) involves two analytical steps.FN6 First, the Board must interpret the claim language, where necessary. Because the PTO is entitled to give claims their broadest reasonable interpretation, our review of the Board's claim construction is limited to determining whether it was reasonable. *In re Morris*, 127 F.3d 1048, 1055 (Fed.Cir.1997). Secondly, the Board must compare the construed claim to a prior art reference and make factual findings that "each and every limitation is found either expressly or inherently in [that] single prior art reference." *Celeritas Techs. Ltd. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360 (Fed.Cir.1998).

In re Crish, 393 F.3d 1253, 1256 (Fed. Cir. 2004).

The Examiner found Li "teaches" the step/instruction in the Abstract and at [0006], [0016] and [0064] Answer 4. The Examiner also cited [0114]-[0117], [0124]-[0128], [0096], [0097], [0011]-[0014], [0007], and claims 27, 33, 38, 40, and 42. Answer 6-7. Accordingly, the Examiner has taken the position that Li expressly describes the step/instruction at issue in the cited passages.

The Appellants disagree that the cited passages/claims in Li teach "determining by a processor an optimal award schedule comprising an optimal combination of suppliers and a list of items to be ordered from each

supplier to at least partially satisfy the purchase requisition utilizing the explicit offer of a business volume discount" (App. Br. 7). In reaching that conclusion, the Appellants have analyzed each of the cited passages. App. Br. 7-8.

We agree with the Appellants. We do not see where precisely Li expressly describes determining an optimal award schedule utilizing the explicit offer of a business volume discount. We have reviewed the passages the Examiner cited but have been unable to find any express description of determining an optimal award schedule *utilizing the explicit offer of a business volume discount*. The passages appear to describe determining an optimal award schedule but no where is there a teaching to utilize the explicit offer of a business volume discount in making that determination.

DECISION

The rejection of claims 1-20 under 35 U.S.C. §102(e) as being anticipated by England is reversed.

REVERSED

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